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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,039	03/13/2001	Hidefumi Yoshida	1095.1166	8847

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EXAMINER
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OYEBISI, OJO O

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/804,039

Applicant(s)

YOSHIDA, HIDEFUMI

Examiner

OJO O. OYEBISI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06/14/2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1,2, 5, 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy (U.S PAT 6,260,024) in view of Lalonde (U.S PAT 5,477,040).

**Re Claim 1,7 and 8:** Shkedy discloses: A transaction supporting apparatus, method and computer-readable recording medium for supporting payment of a transaction made between a buyer and a seller, said apparatus comprising; transaction detail registering means (i.e. Data storage device, see col9, lines 54-57) for registering details of the transaction (i.e. in the database see col9, lines 54-60); payment information notifying means for notifying the buyer of payment information (see col10, lines 48-52); and charging means for charging for the transaction via the credit card account of the buyer (see col19, lines 29-31). Shkedy does not disclose: payment-confirming means confirms that the payment has not been made by the deadline; and charging means for charging for the transaction via the credit card account of the buyer only if said payment confirming means finds that the requested money transfer to the seller's bank account by other means than the registered credit card account has not been

made by the deadline. However, Lalonde discloses a method for making charge transaction further comprising means for initiating a money transfer from a specified bank account of the buyer to the bank account of the seller (i.e., periodic settlement of accounts as by electronic funds transfer, col 11, line 55-67). Lalonde further discloses a charging means wherein said charging means charges for the transaction via the credit card account (i.e., next preferred charge card, col. 10, lines 43-44) if said payment confirming means finds that the requested money transfer to the seller's bank account by other means (i.e., predetermined charge card preference, col. 10, lines 21-24) than the registered credit card account has not been made by the deadline (col. 10, lines 19-50). Thus, it would have been obvious to one of ordinary skill in the art to modify Shkedy to include Lalonde to ensure that sellers can still receive payments in case the buyer's primary account does not have a balance sufficient for the payment to be made by the deadline.

Further, it is well known to one having ordinary skill in the art at the time of invention was made that that when a seller does not receive a payment the seller would have contacted the buyer and requested the buyer to send the payment to the seller. For example, when a person does not pay the electric bill, a letter is sent reminding to make the payment by certain date or else the power would be disconnected. Thus, one of ordinary skill in the art at the time of the invention would have been motivated to have a payment confirming means in the system of Shkedy to provide the buyer a reminder to make the payment.

**Re Claim 2:** Shkedy does not disclose: The transaction supporting apparatus, further comprising means for sending to the buyer a reminder message which reminds the buyer of payment when the payment confirming means confirms that payment has not been made by the deadline, wherein said charging means charges for the transaction via the credit card account of the buyer when a given period described in the reminder message has expired. It is well known in the art that when a seller does not receive a payment the seller would send a reminder message to the buyer and request that the buyer sends the appropriate payment. In addition, Shkedy discloses a payment database storing the credit card number of a buyer (see col10, lines 61-62). Thus, if the buyer fails to pay within a deadline then it would have been obvious that the seller would charge for the transaction. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Shkedy for seller to obtain payment that is due to the seller.

**Re claim 5:** Shkedy does not disclose the transaction supporting apparatus further comprising means for initiating a money transfer from a specified bank account of the buyer to the bank account of the seller, wherein said charging means charges for the transaction via the credit card account if said payment confirming means finds that said account of the buyer does not have a balance sufficient for the payment to be made by the buyer. However, Lalonde discloses a method for making charge transaction further comprising means for initiating a money transfer from a specified bank account of the buyer to the bank account of

the seller (i.e., periodic settlement of accounts as by electronic funds transfer, col 11, line 55-67). Lalonde further discloses a charging means wherein said charging means charges for the transaction via the credit card account if said payment confirming means finds that said account of the buyer does not have a balance sufficient for the payment to be made by the buyer (i.e., credit limit means, col. 10, line 31) (col. 10, lines 31-50). Thus, it would have been obvious to one of ordinary skill in the art to modify Shkedy with the credit limit means of Lalonde to ensure that sellers can still receive payments in case the buyer's primary account does not have a balance sufficient for the payment to be made by the deadline.

3. **Claims 4 and 6** rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy and Lalonde as applied to claim 1 above, and further in view of Martinez (US PAT 5,208,446).

**Re Claim 4:** Shkedy discloses: The transaction supporting apparatus, further comprising means for inputting card information necessary to charge for the transaction via the credit card (see col5, lines 63-65). Lalonde discloses: the method for making charge transaction as stated supra. Shkedy and Lalonde do not disclose: card information wherein said information about the credit card account is information that a delivery service agent who delivers a product to the buyer directly obtains from the buyer at the time of a first transaction by the buyer. Martinez discloses: card information being information that a delivery

service agent who delivers a product to the buyer directly obtains from the buyer at the time of a first transaction by the buyer (see Abstract).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Shkedy by adapting the teaching of Martinez to give the buyer more options such as paying during the delivery of the product.

**Re Claim 6:** Shkedy and Lalonde do not disclose: The transaction supporting apparatus, further comprising means for requesting a home-delivery service agent to deliver a product purchased by the buyer and notifying the home-delivery service agent of information about the buyer, said information about the buyer including an address of a delivery destination. Martinez discloses: The transaction supporting apparatus, further comprising means for requesting a home-delivery service agent to deliver a product purchased by the buyer and notifying the home-delivery service agent of information about the buyer (see col2, lines 45-47) said information about the buyer including an address of a delivery destination (see col2, lines 45-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Shkedy and Lalonde by adapting the teaching of Martinez to give the buyer the option of getting a home delivery and paying during the delivery of purchased products.

4. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy and Lalonde as applied to claim 1 above further in view of Keith Lamond

(Keith hereinafter: Credit Card Transactions Real World and Online, see [http://www.virtualschool.edu/mon/ElectronicProperty/klamond/credit\\_card.htm](http://www.virtualschool.edu/mon/ElectronicProperty/klamond/credit_card.htm), 1996, pgs1-17).

**Re Claim 3:** Shkedy discloses a transaction supporting apparatus supporting payment of a transaction made between a buyer and a seller. Lalonde discloses: the method for making charge transaction as stated supra. Shkedy and Lalonde do not disclose the transaction supporting apparatus, further comprising means for remitting to the seller an amount obtained by subtracting a given service fee from an amount paid by the buyer. Keith discloses a virtual payment system comprising means for remitting to the seller (i.e., a merchant, pg 7) an amount obtained by subtracting a given service fee (i.e., transaction fees, see pg 7) from an amount paid by the buyer (see pg7, #7). Thus, it would have been obvious for one of ordinary skill in the art to modify Shkedy and Lalonde to include Keith's teachings to allow credit card processing intermediary to collect fee for the services rendered for the use of their infrastructure.

### **Response to Arguments**

5. Applicant's arguments filed June 14, 2005 have been fully considered but with respect to the pending claims are moot in view of the new ground(s) of rejection.
  - In response to the applicant's arguments regarding the rejection of claims 1,2,7 and 8 under 35 U.S.C 103, In the applicant's remark, the applicant's states that "there does not appear to be any back-up or safeguard use of a credit card in Shkedy, if the buyer designates a bank account for transfer, if there are



insufficient funds prior to purchase, the transaction is not allowed: there is no teaching of defaulting to a credit card account in such a situation." Contrary to the applicant's assertion, Lalonde compensates for the incomplete teaching of Shkedy by disclosing a charging means wherein said charging means charges for the transaction via the credit card account if said payment confirming means finds that said account of the buyer does not have a balance sufficient for the payment to be made by the deadline (i.e., credit limit means, col. 10, line 31) (col. 10, lines 31-50). Thus, Shkedy in view of Lalonde anticipate the aforementioned limitation.

- In response to the applicant's argument regarding the rejection of claims 4 and 6 under 35 U.S.C. 103. In the applicant's remark, the applicant admits that Martinez teaches the means of merely verifying credit card or other financial transaction data that has already been given to the seller but not obtaining the card information for the first time, i.e., at the first transaction with the buyer." Since Martinez has the verification means, obtaining the card anytime for verification is certainly immaterial in this context. As long as Martinez can verify the credit card account every time Martinez's system is asked to, the matter of when the verification occurs is completely immaterial.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HYUNG S. SOUGH can be reached on (571)272-6799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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